

## REMARKS

In the Notice of Abandonment dated September 24, 2003, the present application is indicated as being abandoned for failure to timely file a proper reply to the Office Action mailed January 16, 2003.

Applicant submits that a Response to Office Action was timely filed on July 16, 2003. Thus, the holding of abandonment is improper and may not be maintained. In this regard, Applicant respectfully submits evidencing materials as Attachments 1-3.

## Attachment 1:

Attached is a copy of the Response to Office Action with a certification of transmission by facsimile stating the date of deposit as July 16, 2003 in compliance with 37 CFR 1.8. All the information with regard to the instant application is correctly represented in the cover page of the Response.

## Attachment 2:

Attached is a copy of the auto-reply facsimile transmission showing that the Response to Office Action was received by the U.S. Patent & Trademark Office on July 16, 2003.

## Attachment 3:

A copy of the Notice of Abandonment Under 37 CFR 1.53 (f) or (g).

The documentary evidence discussed herein and submitted herewith clearly establishes that Applicants timely filed a Response to Office Action on July 16, 2003.

Applicants also note that in the Notice of Abandonment, the Examiner stated that he left a message for Applicants' Attorney on August 6, but that the call was not returned. Applicants respectfully disagree. Applicants' attorney spoke to the Examiner on August 6, 2003 and refaxed the response to the Examiner. Applicants attach herewith Attachment 4, which is a cover sheet and auto-reply facsimile transmission indicating that the Applicants' Attorney refaxed the response on August 6, 2003.

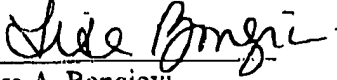
Accordingly, Applicants herein petition to withdraw the holding of abandonment set forth in the Notice of Abandonment dated September 24, 2003. Pursuant to MPEP § 711.03(c), no fee is required for the present Petition. However, if there are any charges due with respect to this Petition or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' attorney.

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PETITIONS OFFICE

For at least the reasons set forth herein above, the holding of Abandonment is improper and may not be maintained; withdrawal thereof and entry of the Response to Notice to File Missing Parts is respectfully requested.

Respectfully submitted,

CANTOR COLBURN LLP

By: 

Lisa A. Bongiovi

Registration No. 48,933

CANTOR COLBURN LLP

55 Griffin Road South

Bloomfield, CT 06002

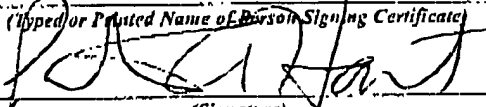
Telephone (860) 286-2929


Facsimile (860) 286-0115

Customer No. 23413

October 6, 2003

# ATTACHMENT 1

CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8)			Docket No.
Applicant(s): Yoshihiro Morimoto et al.			YKI-0066
Serial No. 09/820,140	Filing Date 03/28/2001	Examiner Granvill D. Lee	Group Art Unit 2825
Invention: SEMICONDUCTOR DEVICE AND METHOD OF PRODUCING THE SAME			
<p>I hereby certify that this <u>Petition for Extension of Time (1 pg); Response to Office Action (4 pgs)</u> (Identify type of correspondence)</p> <p>is being facsimile transmitted to the United States Patent and Trademark Office (Fax. No. <u>703-872-9318</u>)</p> <p>on <u>July 16, 2003</u> (Date)</p> <p style="text-align: center;"><u>Patricia A. Hart</u> (Typed or Printed Name of Person Signing Certificate)  (Signature)</p> <p style="text-align: right;">FAX RECEIVED OCT 06 2003 PETITIONS OFFICE</p> <p style="text-align: center;">Note: Each paper must have its own certificate of mailing.</p>			

<b>PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a)</b> <b>(Large Entity)</b>			Docket No. <b>YKI-0066</b>
In Re Application Of: <b>Yoshihiro Morimoto et al.</b>			
Serial No. <b>09/820,140</b>	Filing Date <b>03/28/2001</b>	Examiner <b>Granvill D. Lee</b>	Group Art Unit <b>2825</b>
Invention: <b>SEMICONDUCTOR DEVICE AND METHOD OF PRODUCING THE SAME</b>			
<u><b>TO THE COMMISSIONER FOR PATENTS:</b></u>			
This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a response to the Office Action of <u><b>01/16/2003</b></u> above-identified application. <small style="margin-left: 100px;">Date</small>			
The requested extension is as follows (check time period desired): <div style="display: flex; justify-content: space-between; align-items: flex-start;"><div><input type="checkbox"/> One month</div><div><input type="checkbox"/> Two months</div><div><input checked="" type="checkbox"/> Three months</div><div><input type="checkbox"/> Four months</div><div><input type="checkbox"/> Five months</div></div> <div style="display: flex; justify-content: space-between; align-items: flex-start; margin-top: 5px;"><div>from: <u><b>April 16, 2003</b></u> <small style="margin-left: 40px;">Date</small></div><div>until: <u><b>July 16, 2003</b></u> <small style="margin-left: 40px;">Date</small></div></div>			
The fee for the extension of time is <b>\$930</b> and is to be paid as follows: <div style="margin-top: 5px;"><input type="checkbox"/> A check in the amount of the fee is enclosed.</div> <div><input checked="" type="checkbox"/> The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. <b>06-1130</b></div> <div><input checked="" type="checkbox"/> If an additional extension of time is required, please consider this a petition therefor and charge any additional fees which may be required to Deposit Account No. <b>06-1130</b></div>			
 <small style="margin-left: 100px;">Signature</small>		Dated: <b>July 16, 2003</b>	
Lisa A. Bongiovi Registration No.: 48,933 Customer No.: 23413		<div style="border: 1px solid black; padding: 5px;"><p>I certify that this document and fee is being deposited on _____ with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.</p><div style="border-top: 1px solid black; margin-top: 10px; text-align: center;"><small>Signature of Person Mailing Correspondence</small></div><div style="text-align: center; margin-top: 5px;"><small>via facsimile</small></div><div style="border-top: 1px solid black; margin-top: 5px; text-align: center;"><small>Typed or Printed Name of Person Mailing Correspondence</small></div></div>	
cc:			

**FAX RECEIVED**  
**OCT 06 2003****PETITIONS OFFICE**

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: YOSHIHIRO MORIMOTO ET AL. )  
Serial No. 09/820,140 ) Group Art Unit: 2825  
Filed: March 28, 2001 ) Examiner: G. Lee  
For: SEMICONDUCTOR DEVICE AND )  
METHOD OF PRODUCING THE SAME )

**RESPONSE TO OFFICE ACTION**

Via Facsimile to 703-872-9318  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 223130-1450


FAX RECEIVED

OCT 06 2003

PETITIONS OFFICE

Sir:

In response to the Office Action mailed January 16, 2003, Applicants request reconsideration in view of the following remarks for entry in the above-identified application.

I hereby certify that this correspondence was facsimile transmitted to the United States Patent Office (Fax No. 703-872-9318) on	
July 16, 2003	
(Date of Deposit)	
Patricia A. Harr	
(Name of Person Mailing Paper)	
	07/16/03
Signature	Date

## REMARKS

Claims 1-7 are pending in the application. Applicants request reconsideration in view of the remarks submitted herewith. As will be discussed in detail below, it is believed that the application is in condition for allowance.

Claims 1, 4, and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ohtani et al. (US 5,605,846) ("Ohtani"). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the \* \* \* claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 1 and 4 include the following limitation: "eliminating projections generated by said heating on said non-crystal semiconductor film using a physical elimination method." Claim 7 includes the following limitation: "wherein said non-crystal semiconductor film has a planar surface formed by eliminating, using ion beam irradiation, projections generated on said non-crystal semiconductor film due to heating of said non-crystal semiconductor film." Ohtani does not disclose either of those limitations.

The Examiner asserts that Ohtani teaches using an excimer laser to create a uniform layer; however, Ohtani only discusses making the layer more uniform in terms of its crystallinity. Column 1, lines 52-60 explains that the crystallinity of the silicon film depends on the energy of the laser and thus, it is very difficult to stably obtain a crystalline silicon film with a high reliability. As such, Ohtani is directed to an amorphous silicon film that can be uniformly crystallized with a high reliability. See Column 3, lines 55-58. There is absolutely no disclosure in Ohtani regarding eliminating projections on the semiconductor film. Indeed, there can be no disclosure of eliminating projections in Ohtani because there is no disclosure in Ohtani that projections even exist. Thus, Ohtani does not disclose, either expressly or inherently, all of the limitations of claims 1, 4, and 7. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Claims 2-3 and 5-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ohtani in view of Williams et al (US 6,238,582). For an obviousness rejection to be proper, the

Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1996).

Claims 2-3 and 5-6 include all of the limitations of claim 1. As discussed above, Ohtani does not teach or suggest "eliminating projections generated by said heating on said non-crystal semiconductor film using a physical elimination method." Thus, the references do not teach or suggest all of the limitations of the claims.

Moreover, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); MPEP § 2143.01. There is no teaching in the cited art to combine the references in an attempt to produce the claimed invention. As explained above, Ohtani does not disclose that projections even exist. Thus, there is no motivation for the application of ion milling of Williams after the laser annealing process in Ohtani when Ohtani is not even aware that the projections are created due to the laser annealing process. One skilled in the art would not have combined Ohtani and Williams to reach the claimed invention. Accordingly, Applicants respectfully request that the rejection be withdrawn.

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicants' attorney hereby authorizes that such fee be charged to Deposit Account No. 06-1130.

Respectfully submitted,

CANTOR COLBURN LLP

By: *Lisa Bongiovi*

Lisa A. Bongiovi

Registration No. 48,933

CANTOR COLBURN LLP

55 Griffin Road South

Bloomfield, CT 06002

Telephone (860) 286-2929

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Customer No. 23413

July 16, 2003

## ATTACHMENT 2

USPTO 7/16/03 12:39 PAGE 1/1 RightFAX  
 TO: Auto-reply fax to 8602-5718 COMPANY:

## Auto-Reply Facsimile Transmission



UNITED STATES  
 PATENT AND  
 TRADEMARK OFFICE

TO:

Fax Sender at 8602425718

Fax Information

Date Received:

7/16/03 12:33:14 PM [Eastern Daylight Time]

Total Pages:

6 (including cover page)

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Received  
 Cover  
 Page

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JUL-16-2003 WED 12:44 PM CANTOR COLBURN LLP		FAX NO 8602425718		P. 01
<b>CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8)</b> Applicant(s): Yoshiko Morikawa et al.			Docket No. 152 0866	
Serial No. 09/024,140	Filing Date 03/18/2001	Inventor Grantell D. Lee	Group Art Unit 2816	
Invention: SEMICONDUCTOR DEVICE AND METHOD OF PRODUCING THE SAME				
I hereby certify that this <u>Telexcopy for Transmittal to the United States Patent and Trademark Office</u> is being facsimile transmitted to the United States Patent and Trademark Office (Fax No. 703-872-2218) on <u>July 16, 2003</u> (Date)				
(Signature) <u>Patricia A. Hest</u> (Typed Name)				
Notes: Each page must bear its own transmittal of notice.				
Received from 1501425718 on 7/16/03 12:33:14 PM [Eastern Daylight Time]				

# ATTACHMENT 3



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,140	03/28/2001	Yoshihiro Morimoto	YKI 0066	2123

23413 7590 09/24/2003

CANTOR COLBURN, LLP  
55 GRIFFIN ROAD SOUTH  
BLOOMFIELD, CT 06002

RECEIVED  
SEP 26 2003  
CANTOR COLBURN LLP

EXAMINER

LEE, GRANVILL D

ART UNIT PAPER NUMBER

2825

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notice of Abandonment**

Application No.

09/820,140

Examiner

Granvill D. Lee

Applicant(s)

MORIMOTO ET AL.

Art Unit

2825

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 16 January 2003.
  - (a) ☐ A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b) ☐ A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection. (A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c) ☐ A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a) ☐ The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b) ☐ The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a) ☐ Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

Applicant called on August 6, 2003 and left message but call not returned.

ANTHONY SPATZ  
SUPERINTENDING EXAMINER  
RECEIVED OCT 14 2003

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

# ATTACHMENT 4

**CANTOR COLBURN LLP**  
INTELLECTUAL PROPERTY ATTORNEYS  
55 Griffin Road South  
Bloomfield, CT 06002

Tel: (860) 286-2929

Fax: (860) 286-0115

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**FACSIMILE TRANSMITTAL SHEET**

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DATE: August 6, 2003

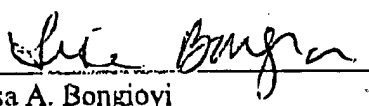
TO: EXAMINER LEECOMPANY: United States Patent & Trademark OfficeFAX NO.: (703) 872-9306

TEL. NO.: \_\_\_\_\_

FROM: Lisa BongioviOUR REF.: YKI-0066 YOUR REF.: 09/820,140TOTAL NUMBER OF PAGES SENT  
(INCLUDING THIS COVER SHEET): 9**COMMENTS:**

This is a copy of correspondence that was faxed to the USPTO on the date of the Certificate of Facsimile Transmission dated July 16, 2003, which includes:

1. Certificate of Facsimile Transmission from July 16, 2003 (1 page)
2. Petition for Extension of Time (1 page)
3. Response (4 page)
4. Transaction Report indicating transmission went through (1 page)
5. Auto-Reply Facsimile Transmission (1 pg)

  
Lisa A. Bongiovi8/6/03  
Date

If there are any problems with this transmission, please call Patty at (860) 286-2929, Ext. 1161.

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**IMPORTANT:** This message is intended only for the use of the individual or entity to which it is addressed, and may contain information that is privileged, confidential and exempt from disclosure under applicable law. If the reader of this message is not the intended recipient, or the employee or agent responsible for delivering it to the intended recipient, you are hereby notified that reading, disseminating, distributing or copying this communication is strictly prohibited. If you have received this communication in error, please immediately notify us by telephone, and return the original message to us at the above address via the U.S. Postal Service. Thank you.

08/06/03 15:11:13

USPTQ-&gt;

8602860137 RightFAX

Page 001

TO: Auto-reply fax to 8602860137 COMPANY:

## Auto-Reply Facsimile Transmission



UNITED STATES  
PATENT AND  
TRADEMARK OFFICE

TO:

Fax Sender at 8602860137

Fax Information

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Total Pages:

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Cover  
Page  
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08/06/2003 15:22 FAX 8602860137

CANTOR COLBURN, LLP

001

CANTOR COLBURN LLP  
INTELLIGENTIAL PROPERTY ATTORNEYS  
55 Chilton Road South  
Bloomfield, CT 06002

Tel: (860) 286-2929

Fax: (860) 286-0115

## FACSIMILE TRANSMITTAL SHEET

DATE: August 6, 2003

TO: EXAMINER LEP

COMPANY: United States Patent &amp; Trademark Office

FAX NO.: (703) 812-9716 TEL. NO.:

FROM: Lisa Bongiovi

OUR REF.: XKL0066 YOUR REF.: 02/280,140

TOTAL NUMBER OF PAGES SENT

(INCLUDING THIS COVER SHEET): 9

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1. Certificate of Facsimile Transmission from July 16, 2003 (1 page)
2. Petition for Extension of Time (1 page)
3. Response (4 page)
4. Transaction Report indicating transmission went through (1 page)
5. Auto-Reply Facsimile Transmission (1 pg)

Lisa A. Bongiovi 8/6/03  
Lisa A. Bongiovi Date

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